

RECEIVED
CENTRAL FAX CENTER

Docket No. 043978-076000

Serial No. 09/851,030

Page 17

JUN 11 2007

REMARKS

The Office Action mailed January 9, 2007, was received and its contents carefully reviewed. Claims 1, 4-8, 12-70, and 72-79 were pending.

In the present Amendment, Applicant amended all independent claims 1, 28, 53, 77, 78, and 79 to provide additional context and details regarding the present invention. Applicant canceled claim 64. Additionally, Applicant amended dependent claims 4-6, 54, 65, 66, and 68 to add additional detail to the claims and to correct dependencies. Support for these amendments may be found throughout the Specification and at least in paragraphs [0018-0022, 0024-0027, and 0029-0036]. As such, Applicant respectfully submits that no new matter was introduced by these amendments.

As now recited, claims 1, 4-8, 12-63, 65-70, and 72-79 are currently pending and are believed to be in condition for allowance. With respect, Applicant requests reconsideration of the present application in light of the above amendments and the following remarks.

A. Claim Rejections Under 35 U.S.C. § 103

Claims 1, 4-8, 12-70, and 72-79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gershman et al. U.S. Patent No. 6,401,085 ("the Gershman patent") in view of Egner et al. U.S. Patent No. 6,931,254 ("the Egner patent"). In view of the amendments above and the comments below, Applicant respectfully requests reconsideration and withdrawal of these rejections under 35 U.S.C. § 103(a).

The present invention relates to a system and method of providing targeted programming to users while they are outside of their homes. The system and method provides targeted programming to users by employing user identification and user profile information as well as reception site information. The system and method of the present invention accesses stored information as well as incorporates additional real-time information such as the immediate location and nature of the current transaction to provide targeted programming to users outside of the home. Users of

the present invention may be grouped by similar profile and reception site information so that targeted programming may be presented to a group outside of their homes.

Applicant amended method claim 1 to positively recite the steps of capturing additional user information from the identified user action and the reception site information, updating a user profile to include the captured additional user information, and processing the updated user profile to provide user determinations regarding user actions. Additionally, Applicant amended system claims 28 and 79 to recite the system components used to perform the method of claim 1. Applicant also amended system claim 53 to highlight the capabilities of the controller with regard to the group profile features of the present invention. Further, Applicant amended independent method claims 77 and 78 to positively recite key features of the computer readable medium having computer readable instructions for carrying out the method of claim 1 of the present invention. With respect, Applicant submits that the combination of the Gershman patent and the Egner patent fails to disclose or suggest the steps of the methods of the present invention as well as the system components required to carry out these steps.

1. Rejection of Method Claims 1, 4-8, and 12-27 under 35 U.S.C. § 103(a)

For example, amended independent claim 1 recites a method for providing targeted programming to a user outside of the user's home. The method includes receiving a user identification associated with a user, the user identification comprising an identifier corresponding to an account number used in a transaction as well as receiving reception site information to identify a user action and a site at which the user action is taking place. Further, amended claim 1 recites capturing additional user information from the identified user action and the reception site information and updating a user profile to include the captured additional user information. Claim 1 also recites receiving the updated user profile based upon the user identification and the additional user information, where the updated user profile includes information characteristic of the user and selecting a targeted program based on the reception site information and the user profile. Likewise, amended claim 1

Docket No. 043978-076000

Serial No. 09/851,030

Page 19

recites processing the updated user profile to provide user determinations regarding user actions, as well as selecting a targeted program based on the reception site information, the updated user profile, and the user determinations. Amended claim 1 also recites providing the targeted program for presentation to a user outside of the user's home.

The Gershman patent, on the other hand, is directed to an agent-based system and method that accesses the Internet to obtain product information for a user. The Gershman patent appears to disclose a hand-held device with Internet Protocol capability that is used with other peripherals to provide an Internet portal (see col. 3, lines 14-18 of the Gershman patent). While, the Gershman patent discloses a method for a client (i.e., web browser) to make a request to a web server for a particular web page, the Gershman patent fails to disclose or suggest a method for providing targeted programming to a user outside of the user's home by receiving a user identification associated with the user, where the user identification includes an identifier corresponding to an account number used in a transaction. Similarly, the Examiner concedes that the Gershman patent fails to disclose or suggest receiving reception site information to identify a user action and a site at which the user action is taking place as recited in amended independent claim 1. Please see the last paragraph on page 3 of the Office Action mailed on January 9, 2007.

In addition, the Gershman patent fails to disclose or suggest the (amended) steps of capturing additional user information from the identified user action and the reception site information and updating a user profile to include the captured additional user information. This "additional information" is captured by the system and method of the present invention by evaluating or otherwise incorporating the identified user action and reception site information. For example, the system and method of the present invention may determine, based upon the identified user action and reception site information, that the user is purchasing a food item at the gas station in the example disclosed in the present Specification. The system and method of the present invention may then update the user's profile to include information about the user's nutritional constitution.

Docket No.043978-076000
Serial No. 09/851,030
Page 20

As further recited in amended independent claim 1, the method of the present invention receives the updated user profile based upon the user identification and the additional user information, where the updated user profile includes additional information characteristic of the user. The method of the present invention recited in amended independent claim 1 further processes the updated user profile to provide user determinations regarding user actions and selects a targeted program based on the reception site information, the updated user profile, and the user determinations. The method of the present invention then provides the targeted program for presentation to a user outside of the user's home.

To continue the gas station example, the system of the present invention receives the updated user profile that incorporates the additional user information (the user purchases garbage food at gas stations, for example). The invention processes the updated user profile and provides user determinations regarding the user actions (the user is eating garbage food at a gas station while there is a restaurant next door to the gas station). The present invention may then select a targeted program based on the reception site information, the updated user profile, and the user determinations (the system may present an advertisement or video or coupon or other targeted programming that includes information about the restaurant next door). Applicants respectfully submit that these (amended) steps are not disclosed nor suggested by the Gershman patent. Additionally, because the Gershman patent fails to disclose or suggest reception site information, there cannot be any disclosure or suggestion of selecting a targeted program based upon reception site information, among other information. The Gershman patent instead focuses on providing web page layout and content information based upon a static user profile (see Fig. 10B and col. 40, lines 28-54 of the Gershman patent).

Applicant amended independent claim 1 of the present application to recite capturing additional user information from the identified user action and the reception site information, updating a user profile to include the captured additional user information, and receiving the updated user profile based upon the user identification and the additional user information, where the user profile includes information

Docket No. 043978-076000

Serial No. 09/851,030

Page 21

characteristic of the user. Applicant further amended independent method claim 1 to include processing the updated user profile to provide user determinations regarding user actions and selecting a targeted program based on the reception site information and the updated user profile and the user determinations. The Gershman patent does not describe a method in which targeted programming content is delivered to a user identified by an account number used in a transaction nor of receiving reception site information to identify a user action and a site at which the user action is taking place. Additionally, the Gershman patent fails to disclose or suggest capturing additional user information from the identified user action and the reception site information as well as updating a user profile to include the captured additional user information. The Gershman patent also fails to disclose or suggest processing the updated user profile to provide user determinations regarding user actions as recited in amended independent claim 1.

As such, Applicant respectfully submits that the Gershman patent fails to disclose or suggest all of the features of amended independent claim 1. Further, the Egner patent fails to remedy the deficiencies of the Gershman patent. For example, there is no disclosure or suggestion in the Egner patent of the capturing and updating steps, nor is there any disclosure or suggestion of updating the user profile to include the captured additional user information and processing the updated user profile to provide determinations regarding user actions as required by amended independent method claim 1.

While the Egner patent appears to disclose a personalized presentation system, the Egner patent focuses on tracking individuals within a particular facility, such as an amusement park or other type of large-area facility (see col. 1, lines 43-54; see also col. 2, lines 42-52). While the Examiner asserts that the Egner patent discloses receiving reception site information to identify a user action and a site at which the user action is taking place, there is no disclosure or suggestion in the Egner patent of the (amended) steps of capturing additional user information from the identified user action and the reception site information and updating a user profile to include the captured additional user information. This "additional information" is captured by the

Docket No. 043978-076000
Serial No. 09/851,030
Page 22

system and method of the present invention by evaluating or otherwise incorporating the identified user action and reception site information. As outlined in the above gas station example, the system and method of the present invention may determine, based upon the identified user action and reception site information, that the user is purchasing a food item at the gas station in the example disclosed in the present Specification. The system and method of the present invention may then update the user's profile to include information about the user's nutritional constitution.

As further recited in amended independent claim 1, the method of the present invention receives the updated user profile based upon the user identification and the additional user information, where the updated user profile includes additional information characteristic of the user. The method of the present invention recited in amended independent claim 1 further processes the updated user profile to provide user determinations regarding user actions and selects a targeted program based on the reception site information, the updated user profile, and the user determinations. The method of the present invention then provides the targeted program for presentation to a user outside of the user's home. There is no disclosure or suggestion in the Egner patent of these additional steps recited in (amended) independent claim 1 of the present application.

Therefore, the combination of the Gershman patent and the Egner patent fails to render claim 1 obvious under 35 U.S.C. § 103(a). As such, Applicant respectfully submits that amended claim 1 is allowable over the combination of the Gershman patent and the Egner patent and requests reconsideration of amended independent claim and withdrawal of the rejection under 35 U.S.C. § 103(a).

Dependent claims 4-8 and claims 12-27 are dependent upon amended independent claim 1, and thereby include all the limitations of independent claim 1, while reciting additional features of the present invention. As noted above, Applicant amended independent claim 1 to include limitations neither disclosed nor suggested by the combination of the Gershman patent and the Egner patent. Accordingly, with the dependency of claims 4-8, and claims 12-27 on amended independent claim 1, the combination of the Gershman patent and the Egner patent fails to disclose or suggest

Docket No.043978-076000

Serial No. 09/851,030

Page 23

all of the features as recited in dependent claims 4-8 and claims 12-27. Applicant respectfully submits that the combination of references thereby fails to render claims 4-8 and claims 12-27 obvious under 35 U.S.C. § 103(a) and that these claims are likewise in proper condition for allowance. Applicant respectfully requests the reconsideration of claims 4-8, and claims 12-27 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

2. Rejection of System Claims 28-52 under 35 U.S.C. § 103(a)

With regard to claims 28-52, Applicant amended independent claim 28 above to recite additional structural features not disclosed or suggested in the cited prior art. As discussed above with regard to amended independent claim 1, Applicant amended claim 28 to recite a user interface device that obtains user identification information, including an account number used in a transaction, as well as reception site information to identify a user action and a site at which the user action is taking place and additional user information from the identified user action and reception site information. Applicant also amended independent claim 28 to recite a controller that receives the user identification information, including an account number used in a transaction, and the reception site information to identify a user action and a site at which the user action is taking place. The system and method of the present invention updates a user profile to include the additional user information, processes the updated user profile to provide determinations regarding user actions, and selects a targeted program based on the user identification information, the reception site information, the additional user information, and the determinations. Further, claim 28 recites that a presentation device receives the targeted program for presentation to a user outside of the user's home.

As indicated above with respect to amended independent claim 1, the combination of the Gershman patent and the Egner patent fails to disclose or suggest these elements that obtain user information, location information, and additional user information from the identified user action and reception site information and that updates a user profile to include the additional information, processes the updated user

Docket No. 043978-076000

Serial No. 09/851,030

Page 24

profile to provide determinations regarding user actions, and selects a targeted program based on these data, and provides the targeted program to a user outside the user's home. The Gershman patent instead focuses on providing web page layout and content information based upon a static user profile (see Fig. 10B and col. 40, lines 28-54 of the Gershman patent).

The Gershman patent does not describe a system utilizing the specific interface device and controller with which targeted programming content is delivered to a user identified by an account number used in a transaction nor of obtaining reception site information to identify a user action and a site at which the user action is taking place as recited in amended independent claim 28. Further, the Gershman patent fails to disclose or suggest a user interface that obtains additional user information from the identified user action and reception site information. Likewise, there is no disclosure or suggestion in the Gershman patent of a controller that updates a user profile to include the captured additional user information or that provides user determinations regarding user actions as recited in amended independent claim 28. Likewise, as outlined above with regard to claim 1, the Egner patent fails to cure the deficiencies of the Gershman patent.

As outlined above, the Egner patent appears to disclose a personalized presentation system that focuses on tracking individuals within a particular facility, such as an amusement park or other type of large-area facility (see col. 1, lines 43-54; see also col. 2, lines 42-52). The Egner patent fails to disclose or suggest the (amended) features of the user interface device and the controller recited in amended system claim 28. For example, there is no disclosure or suggestion in the Egner patent of a user interface device that obtains additional user information from an identified user action and reception site information, nor is there any disclosure or suggestion of a controller that updates a user profile to include the additional user information, processes the updated user profile to provide determinations regarding user actions, and selects a targeted program based on this determination information and additional information. As outlined above with regard to amended independent claim 1, this "additional information" is captured by the system and method of the present

Docket No. 043978-076000
Serial No. 09/851,030
Page 25

invention by evaluating or otherwise incorporating the identified user action and reception site information and using this information to provide determinations regarding user actions.

For these reasons and those discussed above with regard to claim 1, Applicant respectfully submits that the combination of the Gershman patent and the Egner patent fails to disclose or suggest all of the features of amended independent claim 28 and thereby fails to render amended independent claim 28 obvious under 35 U.S.C. § 103(a). As such, Applicant respectfully submits that amended claim 28 is allowable over the combination of the Gershman patent and the Egner patent and requests reconsideration of amended independent claim 28 and withdrawal of the rejection under 35 U.S.C. § 103(a).

Dependent claims 29-52 are dependent upon amended independent claim 28, and thereby include all the limitations of independent claim 28, while reciting additional features of the present invention. As noted above, Applicant amended independent claim 28 to include limitations not disclosed or suggested by the combination of the Gershman patent and the Egner patent. Accordingly, with the dependency of claims 29-52 on amended independent claim 28, the combination of the Gershman patent and the Egner patent also fails to disclose or suggest all of the features recited in amended claims 29-52. Applicant respectfully submits that the combination of references thereby fails to render claims 29-52 obvious under 35 U.S.C. § 103(a) and that these claims are likewise in proper condition for allowance. Applicant respectfully requests the reconsideration of claims 29-52 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

3. Rejection of System Claims 53-70 and 72-76 under 35 U.S.C. § 103(a)

With regard to claims 53-70 and claims 72-76, Applicant likewise amended independent claim 53 above to recite similar structural features recited in amended independent claim 28 and not disclosed or suggested in the cited prior art. Specifically, Applicant amended independent claim 53 to recite additional features

focusing on the group profile capabilities of the system and method of the present invention.

For example, amended independent claim 53 recites an input device that receives a user identification including an identifier corresponding to an account number used in a transaction, reception site information to identify a user action and a site at which the user action is taking place, and additional user information from the identified user action and reception site information. The input device recited in amended claim 53 further includes a user profile database including user profile information. Claim 53 also recites a controller that obtains the user identification, the reception site information, the additional user information, and the user profile information to create an updated group profile information for a group of users. The controller of amended claim 53 further provides determinations regarding user actions and selects a targeted program based on updated group profile information and the determinations. Likewise, claim 53 recites a presentation device that is adapted to present the targeted program to the group of users outside of the users' homes.

With respect, neither the Gershman patent nor the Egner patent, either alone or in combination, discloses or suggests these newly recited features in amended claim 53, including the group profile information and the presentation of the targeted program to the group of users.

As indicated above with respect to amended independent claims 1 and 28, the Gershman patent fails to disclose or suggest the elements that receive user information, location information, and group profile information with which a targeted program is selected and provided to a group outside the home of the group members. The Gershman patent instead focuses on providing web page layout and content information based upon a static user profile (see Fig. 10B and col. 40, lines 28-54 of the Gershman patent).

While the Egner patent appears to disclose a personalized presentation system, the Egner patent focuses on tracking individuals within a particular facility, such as an amusement park or other type of large-area facility (see col. 1, lines 43-54; see also col. 2, lines 42-52). The Egner patent fails to disclose or suggest the (amended)

Docket No. 043978-076000

Serial No. 09/851,030

Page 27

features of the input device and the controller recited in amended system claim 53. For example, there is no disclosure or suggestion in the Egner patent of an input device that receives additional user information from the identified user action and reception site information, nor is there any disclosure or suggestion of a controller that creates updated group profile information for a group of users and that further provides determinations regarding user actions and selects targeted programming based on the updated group profile information. As outlined above with regard to amended independent claims 1 and 28, this "additional information" is captured by the system and method of the present invention by evaluating or otherwise incorporating the identified user action and reception site information and using this information to provide determinations regarding user actions.

For these reasons and those discussed above with regard to claims 1 and 28, Applicant respectfully submits that the combination of the Gershman patent and the Egner patent fails to disclose or suggest all of the features of amended independent claim 53 and thereby fails to render amended independent claim 53 obvious under 35 U.S.C. § 103(a). As such, Applicant respectfully submits that amended claim 53 is allowable over the combination of the Gershman patent and the Egner patent and requests reconsideration of amended independent claim and withdrawal of the rejection under 35 U.S.C. § 103(a).

Applicant canceled claim 64. Dependent claims 54-63, 65-70 and 72-76 are dependent upon amended independent claim 53, and thereby include all the limitations of independent claim 53, while reciting additional features of the present invention. As noted above, Applicant amended independent claim 53 to include limitations not disclosed nor suggested by the combination of the Gershman patent and the Egner patent. Accordingly, with the dependency of claims 54-63, 65-70 and 72-76 on amended independent claim 53, the combination of the Gershman patent and the Egner patent fails to disclose or suggest all of the features as recited in amended claims 54-63, 65-70 and 72-76. Applicant respectfully submits that the combination of references thereby fails to render claims 54-63, 65-70 and 72-76 obvious under 35 U.S.C. § 103(a) and that these claims are likewise in proper condition for allowance.

Applicant respectfully requests the reconsideration of claims 54-63, 65-70 and 72-76 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

4. Rejection of Claims 77, 78, and 79 under 35 U.S.C. § 103(a)

With regard to claims 77, 78, and 79, Applicant likewise amended these independent claims above to recite similar structural features recited in amended independent claims 1, 28, and 53 and not disclosed nor suggested in the cited prior art. As discussed above with regard to amended independent claims 1, 28, and 53, Applicant amended claims 77, 78, and 79 to recite computer readable program code means, code segments, and structural details for presenting targeted programming to a user outside of the user's home.

The combination of the Gershman patent and the Egner patent does not describe an article of manufacture including a computer readable medium having computer readable program code means for causing a computer to perform the steps recited in amended independent claim 77, nor a computer data signal embodied in a transmission medium including the code segments recited in amended independent claim 78, nor a system including the means of claim 79.

As such, Applicant respectfully submits that the combination of the Gershman patent and the Egner patent fails to disclose or suggest all of the features of amended independent claims 77, 78, and 79 and thereby fails to render amended independent claims 77, 78, and 79 obvious under 35 U.S.C. § 103(a). As such, Applicant respectfully submits that amended claims 77, 78, and 79 are allowable over the combination of the Gershman patent and the Egner patent and requests reconsideration of amended independent claims 77, 78, and 79 and withdrawal of the rejection under 35 U.S.C. § 103(a).

RECEIVED
CENTRAL FAX CENTER

Docket No. 043978-076000

Serial No. 09/851,030

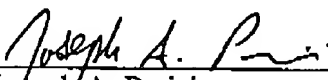
Page 29

JUN 11 2007

B. Conclusion

Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of record and allow claims 1, 4-8, 12-63, 65-70, and 72-79 in the present application to issue. If the Examiner believes that a conference would be beneficial in expediting the prosecution of the present application, Applicant invites the Examiner to telephone counsel to arrange such a conference.

Respectfully submitted,



Joseph A. Parisi
Registration No. 53,435

NIXON PEABODY LLP
Suite 900, 401 9th Street, N.W.
Washington, D.C. 20004-2128
(202) 585-8000